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Supreme Court of the United States

OCTOBER TERM, 1943

No. 108

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,
Petitioner,

vs.

F. W. WOOLWORTH COMPANY,
Respondent.

REPLY BRIEF ON BEHALF OF PETITIONER

W. B. MORTON,
H. STANLEY MANSFIELD,
Counsel for Petitioner.

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This reply brief is believed necessary because of an apparent attempt by respondent to mislead the Court.

Respondent incorrectly asserts that petitioner seeks a review of the doctrine, announced by this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, that the new device must reveal a "flash of creative genius" not "merely the skill of the calling" (Resp. Br. p. 1). Respondent notes that the Seventh Circuit Court of Appeals commented on this rule in the *Chicago Steel Foundry* case*, but the Second Circuit Court of Appeals herein did not. By thus referring to a point in which the decisions of those Courts are not in conflict, respondent seeks to obscure the fact that they are in conflict on the fundamental question of whether invention is to be determined by considering the thing patented or the method of its conception.

**Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. (2d) 812.

Petitioner does not seek a review of this Court's decision in the *Cuno Engineering Corp.* case, *supra.* There, as in earlier decisions, this Court considered "the new device" to determine whether it revealed "the flash of creative genius" or "merely the skill of the calling" (314 U. S. 84, at 91).

The conflict pointed out in the petition herein does not concern the "flash of creative genius" rule to which the Second Circuit Court of Appeals made no reference. It concerns the nature of judicial inquiry in determining patentability, as to which that Court made its position clear. The Second Circuit Court of Appeals decided herein that the thing patented lacked invention because its discovery involved "mere routine work rather than imagination" and because "no particular talent was involved in developing plaintiff's product" (R. 381), thus clearly indicating its inquiry concerned the manner or method of discovery and not the thing discovered. The Seventh Circuit Court of Appeals expressly stated that "*it is the fact of accomplishment,*—novelty appearing, rather than the method of accomplishment with which judicial inquiry is concerned." (132 F. (2d) at 817).

The importance of an authoritative pronouncement by this Court on the conflict respondent seeks to obscure is emphasized by the report of the National Patent Planning Commission, published in a special edition of the Patent, Trade Mark and Copyright Weekly Reports, Vol. 57, No. 12, under date of June 19, 1943. That report characterizes the lack of a uniform test for determining patentable invention as "the most serious weakness in the present patent system" and makes the following recommendation—

> "The Commission therefore recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

Pending enactment of the recommended legislation, a positive ruling by this Court on this question is of great importance to the general public.

Respectfully submitted,

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